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By


Jennifer Archer

Attorney Docket No. 101769-26 / tesa 516 KGB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : BERNHARD MUSSIG
SERIAL NO. : 09/156,886
CUSTOMER NO. : 27384
FILED : September 18, 1998
FOR : SELF-ADHESIVE PROTECTIVE FILM WITH OLEFIN
RUBBER ADHESIVE
ART UNIT : 1733
EXAMINER : John L. Goff II

March 20, 2006

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

APPELLANT'S BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.37

This is an appeal from the final rejection of claims 37-55.

(1) REAL PARTY IN INTEREST

The real party in interest is tesa AG (formerly Beiersdorf AG) by virtue of a first assignment (inventor to Beiersdorf AG) recorded in the United States Patent and

USSN 09/156,886
Appellant's Brief on Appeal

Page 1

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Trademark Office on September 18, 1998, at Reel 9474, Frame 0639; and a second assignment (Beiersdorf AG to tesa AG) recorded on February 1, 2002, at Reel 012590, Frame 0880.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

(3) STATUS OF CLAIMS

The application was originally filed with claims 1-19. A first preliminary amendment dated July 31, 2000, canceled claims 1-19 and added claims 20-39, leaving claims 20-39 then pending. A second preliminary amendment dated March 7, 2001, canceled claims 20-36 and added claims 40-55, leaving claims 37-55 pending.

(4) STATUS OF AMENDMENTS

There have not been any amendments since the final rejection.

(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

There is a single independent claim, claim 37, which relates to a method for *protecting the paint finish of a vehicle or for protecting a painted vehicle component*

against soiling and damage during assembly, transportation or storage, said method comprising applying to said vehicle or vehicle component a self-adhesive protective film, said self-adhesive protective film comprising:

- a) a backing film; and
- b) an adhesive composition coated on said backing film, wherein the adhesive composition comprises a copolymer of at least two different α -olefins having 2 to 12 carbon atoms and at least one further comonomer, said further comonomer being a diene, said adhesive composition not containing 75 mol-% or more of any single α -olefin, and the copolymer having a Mooney viscosity ML (1+4) 125°C of less than 50.

The subject matter of claim 37 finds support in the instant specification at page 2, lines 4-26. The wording in claim 37 that “the adhesive composition comprises a copolymer of at least two different α -olefins having 2-12 carbon atoms and at least one further comonomer, said further comonomer being a diene” finds support at page 2, lines 5-8. The wording “said adhesive composition not containing 75 mol% or more of any single α -olefin” finds support at page 2, lines 8-9.” The requirement that the “copolymer [has] a Mooney viscosity ML (1+4) 125°C of less than 50” is supported by page 2, line 24.

As discussed in the instant specification on page 1, the present invention, as embodied broadly in main claim 37, solves a long-standing problem in the art, i.e.,

protection of motor vehicles in the course of being transported from the manufacturer to the dealer. During that time, the paint finish of such motor vehicles can be damaged, for example, by environmental factors, such as bird droppings. The object which was met by claim 37 and the other appealed claims was to solve this problem by providing a removable self-adhesive films that could be applied to the vehicle or vehicle component during transport, and then easily removed from the vehicle or vehicle component when desired without damaging the paint finish of the vehicle or vehicle component.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The sole issue for consideration is the rejection of claims 37-55 under 35 USC § 103(a) as being obvious over Koga et al., EP 661 364 (“Koga”) in view of Dobashi et al., US 5,643,676 (“Dobashi”).

(7) ARGUMENT

**I. THE COMBINATION OF KOGA AND DOBASHI DOES NOT
MAKE OUT A *PRIMA FACIE* CASE OF OBVIOUSNESS, AND,
THEREFORE, THE REJECTION SHOULD BE REVERSED.**

As should be clear, claim 37 expressly relates to a method of protecting *paint*, i.e., the paint finish of a vehicle or a vehicle part. According to the Examiner, Koga teach a self-adhesive protective film for protecting the surface of a *metal* substrate. Although

vehicles comprise metal, the paint finish of a vehicle is not, in fact, a metal substrate like Koga's.

The Examiner acknowledges this difference between Koga and the present claims.

See the middle of page 3 of the final rejection, wherein the Examiner comments as follows:

“Koga et al. are *silent* as to specifically reciting the *use of the protective film for protecting the paint finish of a vehicle*, it being noted that Koga et al. do not provide any specific uses other than for protecting a coated *metal substrate* from corrosion, dust disposition, or damage during transport or storage.”

Dobashi is cited to show that protective films for paint finishes of vehicles were known in the prior art. Towards the end of page 3 of the final rejection, the Examiner finds that:

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the protective film taught by Koga et al. to protect the paint finish of a vehicle *as it was well known in the art to use protective films* such as those taught by Koga et al. to protect the paint finish of a vehicle from corrosion, dust disposition, or damage during transport or storage as shown for example by Dobashi.”

In response, Appellant submits that this type of summary finding as to obviousness is inadequate, as a matter of law, to discharge the Examiner's initial burden to establish a *prima facie* case of obviousness. The patent law is clear to the following extent: Where the claimed subject matter has been rejected over a combination of prior art references, a *prima facie* case of obviousness is only made out where the prior art would have (1) suggested to those of ordinary skill in the art that they should carry out the claimed process and also (2) revealed to those of ordinary skill in the art that in so carrying out the claimed process, those of ordinary skill in the art would have had a reasonable expectation of success. *See, for example, In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

According to *Manual of Patent Examining Procedure* ("MPEP") § 2143:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Moreover, as reaffirmed by the Court in *In re Regel et al.*, 188 USPQ 136, 139, footnote 5 (CCPA 1975):

“The mere fact that it is *possible* to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.”

The Examiner has not, in fact, shown the film of Koga to be so like those of Dobashi that a person having ordinary skill in the art would have been motivated to use Koga’s film to protect paint finishes with a reasonable expectation of success. The metal surfaces of Koga would have been regarded by those skilled in the art as being so dissimilar to painted surfaces that such persons would not have had a reasonable expectation that the use of Koga’s films to protect a painted surface should be successful. In the absence of such reasonable expectation of success, no *prima facie* case of obviousness is made out.

The Examiner cites Dobashi to show what was well known in the prior art. However, Dobashi only establishes that protective films for paint finishes of automobiles were known, not that Koga’s films would have been useful for that purpose. In the absence of some teaching or suggestion in the prior art that *Koga’s films* would have been suitable for protecting paint finishes of automobiles, the combination of Koga and Dobashi does not make out a *prima facie* case of the obviousness of the instant claims.

Further on this point, Appellant cautions that the Board must consider the specific motivation to combine the references, which Appellant submits is lacking here. As stated

in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, (Fed. Cir. 1999):

“Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. **Close adherence to this methodology is especially important in the case of less technologically complex inventions**, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.’ ...**Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.** [Emphasis added.]”

There is no evidence of motivation to combine Koga and Dobashi, and certainly not in any way as to yield the present invention. Absent such evidence of motivation, the present claims could not have been *prima facie* obvious over the combination of Koga and Dobashi as a matter of law even if, in retrospect, the present invention seems a simple combination of the two.

II. EVEN ASSUMING, FOR THE SAKE OF ARGUMENT, THAT THE COMBINATION OF KOGA AND DOBASHI DOES MAKE OUT A PRIMA FACIE CASE OF OBVIOUSNESS, SUCH *PRIMA FACIE* CASE OF OBVIOUSNESS IS REBUTTED BY THE COMPARATIVE DATA IN THE INSTANT SPECIFICATION ON PAGES 13-18.

In the paragraph bridging pages 2-3 of the Amendment dated January 28, 2005, Appellant wrote the following:

“The Examiner now appears to agree that the data in the instant specification show that the inclusion of the diene component in the adhesive is *critical* to the production of protective film that can be removed from a painted vehicle substrate without defect.”

The Examiner does not object to this statement in the final rejection, and, therefore, presumably agrees with Appellant’s assessment. Indeed, in the first sentence of the last paragraph on page 4 of the Office Action dated January 28, 2004, the Examiner conceded that:

“[Appellant’s] results show including a diene component in the adhesive produces a protective film that is removed from a substrate without defect.”

Those same results, which are summarized below, show that *not including a diene leads to defects in the paint.*

Table

EXAMPLE	COMPOSITION	RESULT OF BONDING TO PAINT
Inventive Examples 1-2	48% propene 48% ethylene 4 % 5-ethylidene-2-norbornene	No defects
Inventive Example 3	59% ethylene 37% propene 4 % 5-ethylidene-2-norbornene	No defects
Inventive Example 4	51% ethylene 44% propene 5% 5-ethylidene-2-norbornene	No defects
Comparison Example 1	80% ethylene 20% 1-butene	Severe paint deformation
Comparison Example 2	90% ethylene 10% 1-butene	Does not bond sufficiently
Comparison Example 3	80% ethylene 10% propene 10% 1-butene	Severe paint deformation
Comparison Example 4	70% vinyl acetate 30% ethylene	Severe paint deformations
Comparison Example 5	25% polyisobutene Mw 1.2 million 75% polyisobutene Mw 35,000	Slight paint deformations in the paint region

As discussed in the specification, beginning at page 10, line 31, and as supported by the data in the specification, which data is summarized in the table above, Appellant has discovered that, quite unexpectedly, the proportion of α -olefins in the adhesive composition and the presence of a diene are result-effective variables affecting paintwork

deformation and other properties. Specifically, Appellant has discovered that unexpectedly superior results are achieved if, as claimed, the adhesive composition comprises “a copolymer of at least two different α -olefins having 2 to 12 carbon atoms and at least one further comonomer, said further comonomer being a diene, said adhesive composition not containing 75 mol-% or more of any single α -olefin.”

It should be clear from the data that when the olefins are manipulated *within* the claimed ranges and combined with a diene, then the removal of the adhesive from fresh paint does not lead to defects. On the other hand, when the olefin are manipulated *outside* the claimed range and do not include the diene, then there are always problems encountered in removing the adhesive from fresh paint.

There is absolutely nothing in the cited combination of Koga and Dobashi that teaches or suggests that the olefin concentration and presence of dienes are result effective variables affecting paint deformability. Consequently, these data of criticality are surprising and unexpected and, thus, objective evidence of nonobviousness. Further, although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner was required to consider the data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Indeed, please see the first full sentence on page 3 of the final rejection, wherein the Examiner writes:

“Koga et al. teach the diene comonomers comprise **0-50%** by weight of the adhesive layer, and the diene components are included for advantages such as lowering the glass transition of the adhesive layer, improving the low temperature adhesion characteristics, and providing an adjustable initial tack.”

Whether Koga teach an advantage in including Appellant’s dienes, the fact is that Koga teaches they are only **optional** ingredients, and, therefore, **not essential**. Thus, Koga teaches the dienes are present at **0-50%** by weight, **0% meaning the adhesive does not contain any dienes at all**. In stark contrast to this, Appellant has demonstrated that the inclusion of the diene is critical for protecting paint finishes. There is absolutely nothing in the combination of Koga and Dobashi that suggests this result. Consequently, the data in the specification are evidence of a surprising and unexpected result, which is, therefore, objective proof of nonobviousness.

Rather than consider the data, the Examiner has so far largely ignored it, apparently on legal grounds. On page 5 of the final rejection, the Examiner comments as follows:

“Koga et al. specifically teach incorporating a diene component for advantages such as lowering the glass

transition of the adhesive layer, improving the low temperature adhesion characteristics of the film, and providing an adjustable initial tack. Therefore, clearly one of ordinary skill in the art would have included a diene component for these advantages, it being further noted the fact that applicant has recognized another advantage which would flow naturally from following the suggestions of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985.)”

Emphasis added.

However, there is no support in *Obiaya*, or anywhere else in the patent law, for that matter, for ignoring data establishing criticality, where, as here, the prior art only generically embraces the claimed invention, and the criticality has been established by comparative testing. *Obiaya* is clearly distinguished from the instant case, *Obiaya* dealing with a situation wherein the prior art disclosed substantially what was claimed, and, apparently, applicants therein did not present any data actually comparing the claimed invention to the prior art. Thus, *Obiaya* cites to *In re Best*, 195 USPQ 430 (CCPA 1970), and *In re Wilder*, 166 USPQ 545 (CCPA 1970), two cases involving situations wherein applicants therein attempted to distinguish prior art disclosing ***substantially what was claimed*** on functional grounds, and ***without comparative data showing an actual difference in properties*** between the claimed compounds and the prior art. See, *Best*, 195 USPQ at 434 (“In view of Hansford’s silence on cool-down rate and on his apparatus,

appellants need only have shown that the cool-down rate, for a typical laboratory-scale sample when employed in Hansford's process, would not yield a cooled zeolite with the X-ray diffraction pattern of claim 3") and *Wilder*, 166 USPQ at 549 ("[T]he mere fact that an applicant has discovered an ***unexpected property*** in a compound which is structurally similar to that disclosed in the prior art is not enough, in and of itself, to make his claimed subject matter unobvious. The law is clear in requiring a showing of ***unexpected differences*** between the properties of the compound recited in the instant claimed composition and those possess by the prior art.")

In the instant case, Appellant does not rest his laurels on the mere discovery of a property that may, in fact, be inherent in the prior art. Rather, Appellant has demonstrated that this property is only possessed by ***certain*** combinations broadly within the cited prior art, ***but not by other*** combinations also broadly within the prior art, thus, proving an actual difference in properties in the form of criticality. Such showing of ***criticality, conceded by the Examiner***, is proof of an unexpected difference in properties, which even under *Obiaya*, *Best* and *Wilder* is proof of nonobviousness.

(8) CONCLUSION

For the foregoing reasons, Appellant respectfully requests that the Honorable Board reverse the final rejection.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Appellant requests that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

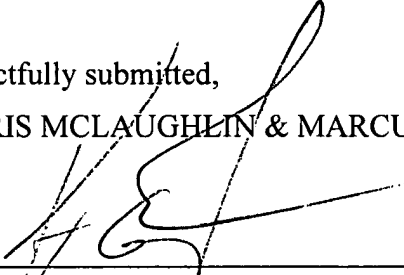
FEES

It is requested that the fee for filing of the Brief on Appeal in the amount of **\$500.00** for other than small entity be charged to the undersigned's **Deposit Account No. 14-1263**.

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By


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(9) CLAIMS APPENDIX

1.-36. (Canceled)

37. (Previously Presented) A method for protecting the paint finish of a vehicle or for protecting a painted vehicle component against soiling and damage during assembly, transportation or storage, said method comprising applying to said vehicle or vehicle component a self-adhesive protective film, said self-adhesive protective film comprising:

- a) a backing film; and
- b) an adhesive composition coated on said backing film, wherein the adhesive composition comprises a copolymer of at least two different α -olefins having 2 to 12 carbon atoms and at least one further comonomer, said further comonomer being a diene, said adhesive composition not containing 75 mol-% or more of any single α -olefin, and the copolymer having a Mooney viscosity ML (1+4) 125°C of less than 50.

38. (Previously Presented) The method according to claim 37, which comprises applying the self-adhesive protective film to a curved surface on an exterior portion of said vehicle.

39. (Previously Presented) The method according to claim 38, which comprises applying the self-adhesive protective film to a painted surface of said vehicle before said vehicle is assembled.

40. (Previously Presented) The method according to claim 37, wherein the diene is present in the adhesive composition in a proportion of between 0.5 and 10% by weight based on the total weight of the adhesive composition.

41. (Previously Presented) The method according to claim 37, wherein the self-adhesive protective film exhibits a UV permeability in the range from 290 to 360 nm of less than 1%.

42. (Previously Presented) The method according to claim 37, wherein the copolymer has a Mooney viscosity ML (1+4) 125°C of less than 30.

43. (Previously Presented) The method according to claim 37, wherein the adhesive composition is cross-linked.

44. (Previously Presented) The method according to claim 37, wherein the copolymer comprises polar comonomers, and the proportion of said polar comonomers in the copolymer is less than 20 mol%.

45. (Previously Presented) The method according to claim 37, wherein the self-adhesive protective film comprises at least one light stabilizer.

46. (Previously Presented) The method according to claim 45, wherein said at least one light stabilizer is selected from the HALS class of light stabilizers.

47. (Previously Presented) The method according to claim 37, wherein the copolymer comprises no more than 65 mol-% of any single α -olefin.

48. (Previously Presented) The method according to claim 37, wherein the self-adhesive protective film exhibits a bond strength on steel between 0.3 and 1.5 N/cm.

49. (Previously Presented) The method according to claim 37, wherein the proportion of each α -olefin in the copolymer is between 5 and 60 mol-%.

50. (Previously Presented) The method according to claim 37, wherein the self-adhesive protective film exhibits a UV permeability in the range from 290 to 400 nm of

below 0.1% and the backing thereof comprises one or more light stabilizers in an amount of at least 0.15% by weight.

51. (Previously Presented) The method according to claim 37, wherein the self-adhesive protective film comprises an adhesion promoter between the backing film and the adhesive composition.

52. (Previously Presented) The method according to claim 51, wherein the adhesion promoter comprises at least one polymer which consists to the extent of at least 50 mol-% of one or more α -olefins.

53. (Previously Presented) The method according to claim 37, wherein the self-adhesive protective film exhibits a force at 10% extension which does not exceed 25 N/15 mm width either in the lengthwise or transverse direction.

54. (Previously Presented) The method according to claim 37, wherein the self-adhesive protective film comprises a backing film which comprises at least one propylene copolymer.

55. (Previously Presented) The method according to claim 37, wherein the self-adhesive protective film is formed by simultaneous coextrusion of the adhesive composition and the backing film.

(10) EVIDENCE APPENDIX

Appellants rely on the data in the instant specification comprising the inventive and comparative examples on pages 13-18 of the instant specification.

(11) RELATED PROCEEDINGS APPENDIX

None.